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09/855,200	05/14/2001	Cindy L. Price	659-787	8178

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EXAMINER

REICHLER, KARIN M

ART UNIT

PAPER NUMBER

3761

DATE MAILED: 10/03/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/855,200	PRICE ET AL.
Examiner	Art Unit	
Karin M. Reichle	3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 03 July 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-46 is/are pending in the application.

4a) Of the above claim(s) 3, 6-7, 12-13, 15, 18-19, 23, 28-29, 33, 36-39, 42-43 and 46 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-2, 4-5, 8-11, 14, 16-17, 20-22, 24-27, 30-32, 34-35, 40-41 and 44-45 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 14 May 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on 03 July 2003 is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) 17,15

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

U.S. Patent and Trademark Office  
PTOL-326 (Rev. 04-01)

**Office Action Summary**

Part of Paper No. 18

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## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 8-8-03 fails to comply with 37 CFR 1.97<sup>©</sup> because it lacks a statement as specified in 37 CFR 1.97(e), i.e. does not state "...first cited in any communication...". It has been placed in the application file, but the information referred to therein has not been considered.

### ***Drawings***

2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 7-3-03 have been disapproved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

The drawing corrections were not approved since all the informalities were not overcome and new issues were raised. For example, the proposed drawing corrections did not include dashed lines denoting edges 14 and 16 as well as dashed lines therefrom in Figure 5. The elements 88 and 90 should not be shown in at least Figures 2-3, i.e. they are not shown in Figure 1 as being above and below 74. Furthermore, while numerals 88, 90 in Figures 2 and 3 were reversed to be consistent with the written description such is now inconsistent with other Figures, e.g. Figure 6. In Figure 17, the left 32 still denotes the elastic. Also Figures 18-19 can show the reduction of side margins 84 and 86 regardless of whether the line of attachment is shown.

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3. The drawings are objected to because in Figure 1, the line from 10 should not be dashed. The lines denoting edges 14 and 16 as well as the lines from the numerals thereto should be dashed to denote underlying structure. This also applies to elastics 36 and the line from the numeral 36. The line from the leftmost 26 and 30 does not denote the correct structure, i.e. appears to denote elastics 38. On the rightmost fastener 42, the attachers 43 should be dashed to denote underlying structure. A line from each numeral 80-86 should be provided and those from 82 and 86 should be dashed. These comments also apply to Figures 5, 9, 13, 17, 21 25 to similar depictions. In Figure 2, a cross section of Figure 1, elements 88 and 90 should not be shown. The line from 74 should extend all the way to the core side. In Figure 3, again 88 and 90 should not be shown. Also the rightmost 80 should have a line to the margin not an arrow. In Figure 4, the lines from 43 and 28 should extend all the way to the structure it denotes. These comments also apply to Figures 6-8, 10-12, 14-16, 18-20, 22-24, and 26-28 to similar depictions. In Figure 5, the line from the rightmost 32 does not denote the correct structure, i.e. appears to denote elastic 36. In Figure 2 the line from the left 80 and in Figure 3, the line from 90 does not denote the right structure. In Figure 9, the line from the right 43 should also be dashed. In Figure 13, the line from 98 does not denote the right structure and the line from 64 should not be dashed. In Figure 17, 88 should be 58. Also the left 32 and right lower 36 do not denote the correct structure. In Figure 20, 44 should be 43. Also, Figure 19 does not show a reduction in the side margins from that show in Figure 18 as set forth in Figure 17. In Figure 21, the line from 114 should not be dashed. The line from 118 does not denote the edge as described. In Figure 22,

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the line from 72 does not extend to the surge layer. In Figure 24, 170 should be 172. In Figure 25, the line from the left 45 does not lead to the connection. Also the numerals (82, 84), 302 and 306 do not denote the proper structure. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

4. Claims 44-45 are objected to because of the following informalities: in the preambles, "absorbent garment" should be --method--(Applicant should also note the preambles of nonelected claims 43 and 46). Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

5. Claims 11, 14, 16-17, 20-22, 24-27, 30-32, 40-41 and 44-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 11, this claim is internally inconsistent, i.e. one side margin includes two side margins, and inconsistent with claim 1, last two lines. Also it is unclear whether it is being claimed that each side margin extends from one of the two sides or each side margin extends from both of the two sides. Claim 11 could be rewritten as --The absorbent garment of claim 1 further comprising a second side margin and wherein said side margin defines a first side

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margin opposite said second side margin and said opposite side margins extend laterally outboard from respective sides of the absorbent composite and terminate in opposite free edges.--

In regard to claim 14, the last four lines are unclear, i.e. does a pair of margins extend from each location or does one of the pair extend from one location and the other of the pair extend from the second location or both, i.e. on the third to last line, should "each of said at least one" be --respective said--? In regard to claim 24, in the second to last section, the last four lines are also unclear, see discussion with respect to claim 14, i.e. should "at least one of said at least one" be --respective said --?

#### *Claim Language Interpretation*

6. In claim 14, last line "not attached" is interpreted as not being directly attached. This also applies to claim 24.

#### *Claim Rejections - 35 USC § 102*

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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8. Claims 1-2, 4-5, 8-11, 14, 16-17, 20-22, 24-27, 30-32, 34-35, 40-41 and 44-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Buell '115.

See Figures 1-2, Figure 7, Figure 9, Figure 9a, Figure 10, Figure 10a, Figure 11a, col. 3, lines 38-61, i.e. body panels are half belts 26 and 30, absorbent composite is body member 22 which includes a backsheet 41, a topsheet 40, a retention portion 42, the composite which is connected to the body surface of the half belts at longitudinally extending locations inwardly of proximal edges 71 and side margins are formed between edges 48 and 71 of both the topsheet and backsheet extending outward of the side edges of the core 42 and include an elastic element which extends less than the entire length of the composite. With regard to the method claims, see col. 3, lines 27-34 and col. 6, lines 24-50. See also response to Applicant's arguments infra.

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321<sup>©</sup> may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-2, 4-5, 8-11, 14, 16-17, 20-22, 24-27, 30-32, 34-35, 40-41 and 44-45 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 4-5, 8-11, 13, 15-16, 19-21 of copending Application No. 10/053,251. Although the conflicting claims are not identical, they are not patentably distinct from each other because since the instant application was filed prior to '251 but there was no administrative delay, the one way *In re Vogel* test applies, i.e. are the claims in the instant application obvious in view of the claims of the '251 application. The answer is yes. The claims of the instant application are broader than the '251 claims. Once the Applicant has received a patent for a species or more specific embodiment Applicant is not entitled to a patent for the generic or broader invention. This is because the more specific anticipates the broader. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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***Response to Arguments***

11. Applicant's remarks on page 14 and page 16 have been noted but are either deemed moot in that such issue has not been reraised or is deemed nonpersuasive for the reasons set forth supra. Applicant's remarks on page 15 have been noted but are deemed nonpersuasive in that such are narrower than the claim language. Claim 1, for example, requires a composite to be connected to a panel along a location and a side margin to extend laterally outboard from that location and terminate in a free edge. In addition to the portions of Buell cited supra also see col. 2, lines 42-43 and col. 5, lines 23-26. It is noted that claim 1 does not require that the location be the outermost lateral location of attachment, claim 1 does not require that the entire width of the margin be laterally outboard to such location, claim 1 does not require the entire side edge of the margin to be free. It is noted that Buell at the very least shows a side margin extending laterally outboard of a location of attachment and terminating in an edge that is free, i.e. those portions between 76 and 77. It is the Examiner's position that Buell shows a side margin extending outwardly of the outermost lateral location of attachment, see Figure 7, right below numeral 71, the margin curves away from the location of attachment and that curve is outboard thereof. With regard to claims 14 and 24, see the discussion of claim 1 supra and again noted the definition in the Claim Language Interpretation section supra.

***Conclusion***

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12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any new grounds of rejection were necessitated by the amendments to claims 11, 14 and 24.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to K. M. Reichle whose telephone number is 703-308-2617. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo, can be reached on (703) 308-1957. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

*K.M. Rechle*  
**KARIN RECHLE**  
**PATENT EXAMINER**

KMR

September 28, 2003